No. 231.

UNITED STATES CIRCUIT COURT OF APPEALS, NINTH CIRCUIT.

(October Term, 1894.)

JOHN HAMMOND,

Plaintiff in Error,

vs.

STOCKTON COMBINED HARVESTER AND AGRICULTURAL WORKS,

Defendant in Error.

Motion to Certify Questions of Law to the Supreme Court in connection with Petition for Rehearing.

JOHN H. MILLER,
For the Motion.

GEO. SPAULDING & CO., PRS., 414 CLAY ST., SAN FRANCISCO.

UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

OCTOBER TERM OF THE YEAR EIGHTEEN HUNDRED AND NINETY-FOUR.

JOHN HAMMOND,
Plaintiff in Error,
vs.
STOCKTON COMBINED HARVESTER AND AGRICULTURAL WORKS,
Defendant in Error.

No. 231.

Motion on Behalf of Plaintiff in Error to Certify to the Supreme Court Certain Questions and Propositions of Law Hereinafter Stated.

Now comes John Hammond, plaintiff in error, and respectfully shows to this court that heretofore, to wit: on October 31st, A. D. 1895, this court rendered a judgment and decree in the above-entitled case, affirming the judgment of the lower court to which the writ of error herein was directed. That said decree of this court was made on the ground that the letters patent, numbered 21,042, granted to John Hammond on September 15, 1891, for a new and useful design for a car-body, were invalid by reason of the absence of any display of the inventive faculty in producing said design.

That thereafter, to wit: on the 16th day November, A. D. 1895, the plaintiff in error filed in this honorable

court a petition for rehearing of said case; that said petition has not yet been determined, but is still pending in this court, and in order to properly determine the same it will be necessary for this court to pass upon those certain questions and propositions of law hereinafter stated.

That the said questions and propositions of law referred to are the following:

I.

Is there any difference or distinction in kind, character, or nature, between the faculty of invention necessary to be displayed in producing A MECHANICAL DEVICE *which is patentable under the provisions of section 4888 of the revised statutes, and the faculty of invention necessary to be displayed in producing* A DESIGN *which is patentable under the provisions of section 4929 of the revised statutes?*

II.

In determining whether or not an exercise of the inventive faculty has been displayed in the production of a new, useful, and original SHAPE OR CONFIGURATION OF AN ARTICLE OF MANUFACTURE, *patentable under section 4929 of the revised statutes, do the same rules of law apply which apply in determining whether or not an exercise of the inventive faculty has been displayed in the production of* MECHANICAL DEVICES, *patentable under section 4888 af the revised statutes?*

III.

What is the proper test by which to determine the presence or absence of an exercise of the inventive faculty displayed in producing a DESIGN CONSISTING OF A NEW, USEFUL AND ORIGINAL SHAPE OR CONFIGURATION OF AN ARTICLE OF MANUFACTURE?

IV.

Was an exercise of the inventive faculty displayed by John Hammond in producing the design shown and claimed in letters patent numbered 21,042, issued to him on September 15, 1891, and sued on herein?

V.

Is the design patent No. 21,042 issued to John Hammond on September 15, 1891, invalid because of a want of invention displayed in producing it?

It is respectfully submitted that this court, in rendering the judgment and decree complained of, either *failed entirely to pass upon or incorrectly or improperly passed upon the first three of the foregoing questions*, and that the court improperly and incorrectly decided the last two of said questions.

That the points involved in questions 1, 2 and 3, hereinabove referred to, ARE ENTIRELY NEW QUESTIONS IN THIS CIRCUIT, inasmuch as this case is *the first case involving a patent for a* DESIGN *that has been brought to this court.* That the opinion rendered in this case by this court is silent as to said three questions, and does not purport upon its face to pass upon the same; that if any inference can be drawn from said decision to the effect that said questions were passed upon and considered by the court in reaching its conclusion, the inference would be that said court answered the first of said questions in the negative and the second of said questions in the affirmative, *whereas the first of said questions should have been answered in the affirmative and the second of said questions in the negative.*

It is further suggested to your Honors that, inasmuch as *this is the first case involving a design patent brought to this court*, the decision herein fixes, establishes and lays down the policy of the court generally with regard to design patents, and it is of great importance that the policy of the court in relation to design patents should be correct, and for that reason this case is one of very great importance to all the holders of design patents, and to persons who have any connection therewith.

It is further submitted that within the last two years a vastly increased number of design patents have been issued, and a vastly increased number of suits have been had in other circuits concerning such patents, and that the policy of the courts in deciding such cases is universally favorable and lenient towards design patents, holding that *they stand on a different basis from mechanical patents, that different rules of law apply to them, that only a minimum amount of the inventive faculty is necessary in producing them, and that they stand very nearly on the same plane as trade-marks and copyrights.*

We have made a careful perusal of all the recent cases involving design patents, and we have deduced the above conclusions therefrom.

It is further submitted that in the decisions of the Supreme Court of the United States involving design patents substantially these views obtain, and that said court views with favor patents of that kind, and has refused to apply to design patents the strict rules of law which said court has heretofore applied to mechanical patents in determining the presence or absence of the inventive faculty in a given case.

For the foregoing reasons, and in order that there may

be a final decision upon the novel questions presented by the petition for rehearing, the plaintiff in error comes now and moves this court, under the provisions of section 6 of "An act to establish Circuit Courts of Appeal and to define and regulate in certain cases the jurisdiction of the courts of the United States, and for other purposes," approved March 3, 1891, to certify to the Supreme Court of the United States those certain five questions and propositions of law hereinabove stated, in order that this court may properly and correctly decide the petition for a rehearing now pending.

And inasmuch as a ruling and decision upon the said five questions and propositions of law will necessarily require an examination of the whole case, the plaintiff in error also moves the court to transmit to the Supreme Court, with its certificate of said questions and propositions, the entire record in the case.

In connection with this motion we ask that your Honors will carefully read and consider the argument made by us in the petition for rehearing heretofore filed.

All of which is respectfully submitted.

JOHN H. MILLER,
Counsel for Petitioner.

Notice of Motion to John L. Boone, Esq., Attorney for Defendant in Error.

You are hereby notified that on Monday, the second day of December, A. D. 1895, I shall move the above-entitled court, at the court-room thereof, in the City and County of San Francisco, at 11 o'clock A. M., to grant the above-entitled motion.

JOHN H. MILLER,
Counsel for Petitioner.